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Naohisa Kitazato

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EXAMINER

ZELASKIEWICZ, CHRYSTINA E

ART UNIT

PAPER NUMBER

3621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,676	Applicant(s) KITAZATO ET AL.	
	Examiner CHRYSTINA ZELASKIEWICZ	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-21 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>June 5, 2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Restrictions

1. Claims 1-13 are withdrawn from further consideration pursuant to 37 C.F.R. § 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 20, 2009.
2. Applicant's election without traverse of Group II, claims 14-21, in the reply filed on July 20, 2009 is acknowledged.

Acknowledgements

3. This action is in reply to the Response to Restriction Requirement filed on July 20, 2009.
4. Claims 1-21 are pending.
5. Claims 1-13 have been withdrawn.
6. Claims 14-21 have been examined.
7. This Office Action is given Paper No. 20091204 for references purposes only.

Priority

8. Receipt is acknowledged of papers submitted under 35 U.S.C. §§ 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

9. The Information Disclosure Statement filed on June 5, 2006 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Specification

10. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1), MPEP §608.01(o), and MPEP §2181 IV and its discussion of 37 C.F.R. §1.75(d)(1). Appropriate correction of the following is required:

- a. “means for supplying the main license” in claim 14;
- b. “means for supplying the encrypted content” in claim 14.

Claim Objections

11. Claim 16 is objected to because it states “**MPGE**-2 transport stream.” To be consistent with claim 18, Examiner will assume Applicant intended “**MPEG**-2 transport stream.” Appropriate correction is required.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 19-21 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

14. Regarding claim 19, based on Supreme Court precedent¹ and recent Federal Circuit decisions, a § 101 patent eligible process must (1) be tied to a particular machine (or apparatus); or (2) transform a particular article to a different state or thing. See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008) (en banc). This is called the Machine-or-Transformation Test.

c. To meet prong (1), the method steps should positively recite the machine to which it is tied. Alternatively, or to meet prong (2), the method steps should positively recite the material that is being changed to a different state, or positively recite the subject matter that is being transformed. For example, a method claim that would *not* qualify as a patent eligible process because it fails both prongs of the Machine-or-Transformation Test would be a claim that recites purely mental steps.

d. In this particular case, the process claims fail prong (1) because the method steps of supplying are not tied to a specific machine since the method step could be performed by a human being. Finally, Examiner notes that the claims fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

15. Regarding claims 20-21, under the broadest reasonable interpretation standard these claims recite a computer program only. "Computer programs claimed as

computer listings per se, *i.e.*, the descriptions or expressions of the programs, are not physical ‘things.’ They are neither computer components nor statutory processes, as they are not ‘acts’ being performed.” MPEP §2106.01 I. Because the claims recite only abstractions that are neither “things” nor “acts,” the claims are not within one of the four statutory classes of invention. Because the claims are not within one of the four statutory classes of invention, the claims are rejected under 35 U.S.C. §101.

e. Claim 20 is directed to a recording medium having recorded therein a computer-readable program. Because Applicant’s specification does not lexicographically define “medium” or show support for it to be hardware, Examiner uses the broadest reasonable interpretation to define “medium” as software (see claim interpretation below). Thus, Examiner interprets claim 20 as directed to software alone.

f. As recited, claim 21 is directed to a program which allows a computer to perform a process. However, under the current guidelines of 35 USC 101, computer software must be tangibly embodied on a computer readable medium, and, when executed by a computer processor, perform the steps of the software. In their broadest reasonable interpretation and in light of the specification, claim 21, as recited, can be interpreted to be embodied on abstract mediums such as carrier waves and signals, and therefore not eligible for patent protection.

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

Claim Rejections - 35 USC § 112, 2nd paragraph

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. Claims 14-18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

18. The following claim elements are means (or step) plus function limitations that invoke 35 U.S.C. 112, sixth paragraph:

g. “means for supplying the main license” in claim 14;

h. “means for supplying the encrypted content” in claim 14.

19. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. Applicant is required to:

i. Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

j. Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

20. If Applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts

perform the claimed function, applicant is required to clarify the record by amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)).

21. Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 14-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Leung et al. (US 2006/0150257).

Claims 14, 19, 20, 21

24. Leung discloses the following limitations:

k. a first supplying means (license server) for supplying the main license (digital license) to the content processing apparatus (device) over a network (figure 1, abstract, P0037); and

l. a second supplying means (content server) for supplying the encrypted content (content is encrypted) and a license information file including a sub license (sub-license) and license type identification information (instructions/rules) for identifying the sub license corresponding to a type of viewing (e.g. preview) to the content processing apparatus (device) over the network (figure 1, abstract, P0037, 0040-0042, 0052).

25. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Leung to show the license type identification information identifies a sub license corresponding to a type of viewing because Leung already discloses a sub license and instructions/rules accompanying the content, which may include formatted license acquisition script and preview information (abstract, P0037, 0040-0042, 0052). A suggestion exists that the identification information (i.e. instructions/rules) identify a sub license because the instructions/rules already identify terms and conditions (e.g. preview) of how to view the content (i.e. just like a sub license would) (P0040-0042, 0052).

Claim 15

26. Leung discloses all the limitations above. Furthermore, Leung discloses the following limitations:

m. the license type identification information (instructions/rules) is to discriminate between a sub license for preview (preview information) and a sub license for actual viewing (license to view content) (P0040-0042, 0052).

Claim 16

27. Leung discloses all the limitations above. Furthermore, Leung discloses the following limitations:

n. the second supplying means supplies the encrypted content (encrypted content), encrypted preview sub license (encrypted rules), encrypted actual-viewing sub license (sub-license) and a license information file including license type identification information (instructions/rules) for discriminating between the encrypted preview and actual-viewing sub licenses, as an MPEG-2 transport stream (stream data), to the content processing apparatus over the network (figure 1, abstract, P0037, 0040-0042, 0052, 0062-0064).

28. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Leung to show license type identification information discriminates between the encrypted preview and actual-viewing sub licenses because Leung already discloses instructions/rules accompanying the content, which may include formatted license acquisition script and preview information (abstract, P0037, 0040-0042, 0052).

A suggestion exists that the identification information (i.e. instructions/rules) discriminate between the encrypted preview and actual-viewing sub licenses because the instructions/rules already identify terms and conditions (e.g. preview) of how to view the content (P0040-0042, 0052).

29. Additionally, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Leung to show the second supplying means supplies all this data as a MPEG-2 transport stream because Leung already discloses various output formats and multiple streams (P0062-0064). A suggestion exists to use a MPEG-2 transport stream because various output formats may assist in delivering content to the user (P0062).

Claim 17

30. Leung discloses all the limitations above. Furthermore, Leung discloses the following limitations:

- o. the license information file is ECM (P0046, 0051, 0062).

31. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Leung to show the license information file is ECM because Leung already discloses data compression and various compressed formats (P0046, 0051, 0062). A suggestion exists to have the license information file as ECM because various output formats may assist in delivering content to the user (P0046, 0051, 0062).

Claim 18

32. Leung discloses all the limitations above. Furthermore, Leung discloses the following limitations:

- p. the second supplying means supplies the MPEG-2 transport stream by multicasting (multi streaming) to the content processing apparatus over the network (P0062-0064).

Claim Interpretation

33. After careful review of the original specification and unless expressly noted otherwise by Examiner, Examiner concludes that Applicant is not his own lexicographer. See MPEP § 2111.01 IV.

34. Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), Examiner points to these other sources to support his interpretation of the claims.² Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

- q. **medium** “A substance in which signals can be transmitted.” Computer Dictionary, 5th Edition, Microsoft Press, Redmond, WA, 2002; and

² While most definitions are cited because these terms are found in the claims, Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

r. **network** “(3) (A) (software) An interconnected or interrelated group of nodes.” IEEE 100 The Authoritative Dictionary of IEEE Standards Terms, 7th Edition, IEEE, Inc., New York, NY, Dec. 2000.

35. In light of Applicants’ choice to pursue product claims (claims 14-18, 20-21), Applicants are reminded that functional recitation(s) using the word and/or phrases “for”, “adapted to”, or other functional language (e.g. see claims 14, 20, and 21 which recite “identification information for identifying”) have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, all limitations have been considered. However, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such a machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 31.06 II (C.), 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in the paragraph apply to all claims currently pending.

36. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure (see attached form PTO-892).

Conclusion

37. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Chrystina Zelaskiewicz whose telephone number is 571.270.3940. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at 571.272.6779.

38. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866.217.9197 (toll-free).

/Chrystina Zelaskiewicz/
Examiner, Art Unit 3621
December 4, 2009

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621